

### **REMARKS**

In the non-final Office Action, the Examiner withdraws claims 12-41 as being drawn to a non-elected invention; objects to Figures 1 and 2 of the Drawings indicating that they should be labeled as "Prior Art;" objects to claim 3 because of a minor informality; rejects claims 9-11 under 35 U.S.C. § 101 as directed to non-statutory subject matter; and rejects claims 1-11 under 35 U.S.C. § 102(e) as anticipated by FAIN et al. (U.S. Publication No. 2003/0220912). Applicants respectfully traverse the drawing objection and the claim objection and rejections.<sup>1</sup>

By way of the present amendment, Applicants amend claim 11 to improve form. No new matter has been added by way of the present amendment. Claims 1-41 remain pending. Of these claims, claims 12-41 have been withdrawn due to a restriction requirement.

### ***RESTRICTION REQUIREMENT***

Applicants continue to traverse the restriction requirement and respectfully request that the Examiner examine claims from Group II of the restriction requirement. For example, independent claim 34 recites a memory configured to store a list of commercial query patterns, and a processor configured to determine whether the received user query is a commercial query based at least in part on the list of commercial query patterns. This claim includes features that are similar to (yet possibly of different scope

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<sup>1</sup> As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, etc.) is not a

than) features recited in Applicants' claims 1 and 2. As a second example, independent claim 40 recites a memory configured to store a list of query patterns of a first type, and a processor configured to determine whether the received user query is a query of the first type based at least in part on the list of query patterns. This claim includes features that are similar to (yet possibly of different scope than) features recited in Applicants' claims 1 and 2. Applicants respectfully request that the Examiner reconsider the restriction requirement and properly examine at least claims 34 and 40 in addition to claims 1-11.

#### *DRAWINGS*

The drawings stand objected because Figures 1 and 2 should allegedly be designated by a "Prior Art" legend because only that which is old is allegedly illustrated. Applicants respectfully disagree.

Figures 1 and 2 are described in the Detailed Description section of the specification. As described in Applicants' specification, Figure 1 illustrates an exemplary diagram of a system in which systems and methods consistent with the principles of the invention may be implemented (paragraph 0014). Applicants describe that the system of Figure 1 includes a server, which is further described with regard to Figure 2. The server is described in Applicants' specification as implementing certain functions consistent with the principles of the invention (see, e.g., paragraphs 0027). Therefore, Applicants submit that Figures 1 and 2 do not constitute prior art.

Accordingly, Applicants respectfully request that the requirement for a "Prior Art" legend be reconsidered and withdrawn.

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concession by Applicants that such assertions are accurate or such requirements have been met, and

*CLAIM OBJECTION*

Claim 3 stands objected due to an informality. In particular, the Office Action alleges that:

[t]he specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

[r]egarding Claim 3, this claim recites the limitation "when the query is not included in the predetermined list of commercial query patterns" (in lines 2-3). There is insufficient antecedent basis for this claim limitation.

(Office Action, pg. 2). Applicants respectfully submit that the specification, as originally filed, provides clear support for the above feature of claim 3.

Applicants direct the Examiner's attention to blocks 520 and 540 in Figure 5 and paragraph 0060, which specifically disclose determining, when a query is not included in a predetermined list of commercial query patterns, whether the query relates to at least one commercial query pattern in the predetermined list of commercial query patterns.

For at least the foregoing reasons, Applicants respectfully request that the objection to claim 3 be reconsidered and withdrawn.

*REJECTION UNDER 35 U.S.C. § 101*

Claims 9-11 stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. In particular, the Office Action alleges:

[c]laims 9-11 are not statutory because they are directed to a signal which is nonstatutory because a signal is not tangible. The claim lacks a tangible results as required by Sate Street. The disclosure (in [0027], lns. 3-8) defines computer readable medium to be a signal (carrier waves): "A computer-readable medium may be defined as one or more memory devices and/or carrier waves."

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Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

While not acquiescing in the Office Action's rejection, but solely to expedite prosecution, Applicants amend claim 11 herein to address the concerns raised in the Office Action. Thus, Applicants respectfully request that the Office reconsider and withdraw the rejection of claim 11 under 35 U.S.C. § 101. Applicants respectfully traverse the rejection of claims 9 and 10.

At the outset, Applicants note that claims 9 and 10 are not directed to a signal. Instead, claim 9 is directed to a system and claim 10 is directed to a server. Applicants submit that the Office Action's allegations in no way relate to claims 9 and 10.

Moreover, Applicants note that the USPTO specifically states, in the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Nov. 22, 2005 O.G. Notice) (hereinafter "Guidelines"), the following:

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

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The burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the examiner must provide an explanation. ... If the examiner can establish a prima facie case that a claim does not fall into a statutory category, that does not preclude complete examination of the application for satisfaction of all other conditions of patentability. The examiner must further continue with the statutory subject matter analysis as set forth below.

Despite this clear obligation, the Office Action does not provide any evidence that claims 9 and 10 do not fall within one of the four enumerated categories of patentable subject matter recited in Section 101. Applicants respectfully submit that each of independent

claims 9 and 10 falls within one of the four enumerated categories of patentable subject matter recited in Section 101.

For at least the foregoing reasons, Applicants submit that the rejection of claims 9 and 10 under 35 U.S.C. § 101 is improper.

*REJECTION UNDER 35 U.S.C. § 102*

Claims 1-11 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by FAIN et al. Applicants respectfully traverse this rejection.

A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. FAIN et al. does not disclose or suggest the combination of features recited in claims 1-11.

For example, independent claim 1 is directed to a method for processing a query. The method includes receiving a query; determining whether the query is a commercial query or a non-commercial query; processing the query in a first manner when the query is determined to be a non-commercial query; and processing the query in a second, different manner when the query is determined to be a commercial query. FAIN et al. does not disclose or suggest this combination of features.

For example, FAIN et al. does not disclose or suggest determining whether a received query is a commercial query or a non-commercial query. The Office Action relies on paras. 0019 and 0046, of FAIN et al. as allegedly disclosing this feature (Office Action, pg. 4). Applicants respectfully disagree with the Office Action's interpretation of FAIN et al.

At para. 0019, FAIN et al. discloses:

It is therefore an object of the present invention to provide a system and method for examining and categorizing records in a distributed database as commercial or non-commercial records and then presenting those records in response to a database query submitted by a user or network-defined settings.

This section of FAIN et al. discloses categorizing records in a database as commercial or non-commercial. This section of FAIN et al. does not disclose or suggest determining whether a received query is a commercial query or a non-commercial query, as recited in claim 1. Categorizing records in a database as commercial or non-commercial is not the same as determining whether a received query is a commercial query or a non-commercial query and the FAIN et al. disclosure does not indicate that these different acts are equivalent.

At para. 0046, FAIN et al. discloses:

Distinct sets of search results for commercial pages and informational pages returned in response to a user-defined query, are provided to advertisers, search engine service providers and users. The system distinguishes pages according to the commercial nature of each page, and thereby provides more relevant results by providing relevant search results to those users seeking information or to enter into a commercial transaction, without confusing the two categories of search results. The system also enables complete customization with regard to the set of criteria used to categorize search results, the importance of each such criterion in the determination of such categorization, and the ultimate categorization and presentation of such search results to the user.

This section of FAIN et al. discloses that the criteria used to categorize search results can be customized. This section of FAIN et al. does not disclose or suggest determining whether a received query is a commercial query or a non-commercial query, as recited in claim 1.

In stark contrast to the above feature of claim 1, FAIN et al. discloses, with reference to Fig. 6, that in response to a search term or phrase, the system generates pages according to a relevance method (steps 260 and 262, Fig. 6; para. 0079). The system then categorizes the pages according to categorization criteria, which may be specified by the user (step 264, Fig. 6; para. 0079). The system presents the categorized pages to the user according to the user's preferences, which may include presenting pages in some categories and not presenting pages in other categories (step 266, Fig. 6; paras. 0078 and 0079). FAIN et al. does not disclose or suggest determining whether a received query is a commercial query or a non-commercial query, as recited in claim 1. Moreover, FAIN et al. does not disclose or suggest processing the query in a first manner when the query is determined to be a non-commercial query; and processing the query in a second, different manner when the query is determined to be a commercial query, as also recited in claim 1.

For at least the foregoing reasons, Applicants submit that claim 1 is not anticipated by FAIN et al.

Claims 2-8 depend from claim 1. Therefore, these claims are not anticipated by FAIN et al. for at least the reasons given above with respect to claim 1. Moreover, these claims recite additional features not disclosed or suggested by FAIN et al.

For example, claim 2 recites that determining whether a received query is a commercial query or a non-commercial query includes determining whether the query is included in a predetermined list of commercial query patterns, and identifying the query as a commercial query when the query is included in the predetermined list of

commercial query patterns. FAIN et al. does not disclose or suggest this combination of features.

For example, FAIN et al. does not disclose or suggest determining whether the query is included in a predetermined list of commercial query patterns. The Office Action relies on para. 0026 of FAIN et al. for allegedly disclosing this feature (Office Action, pg. 4). Applicants respectfully disagree with the Office Action's interpretation of FAIN et al.

At para. 0026, FAIN et al. discloses:

A further object of the present invention is to provide a system and method for categorizing records in a distributed database to identify commercial records and compare those records against a pay for performance search engine's listings in order to further categorize commercial records as either participating advertisers or non-participating advertisers.

This section of FAIN et al. discloses comparing commercial records against a pay for performance search engine's listing to further categorize commercial records as either participating advertisers or non-participating advertisers. This section of FAIN et al. does not relate to determining whether a received query is included in a predetermined list of commercial query patterns, as recited in claim 2. In fact, this section of FAIN et al. does not even relate to queries. If this rejection is maintained, Applicants respectfully request that the Office explain how the above section of FAIN et al. can reasonably be construed as disclosing determining whether a received query is included in a predetermined list of commercial query patterns, as recited in claim 2.

Since FAIN et al. does not disclose or suggest determining whether a received query is included in a predetermined list of commercial query patterns, FAIN et al.

cannot disclose or suggest identifying the query as a commercial query when the query is included in the predetermined list of commercial query patterns, as also recited in claim

2. The Office Action relies on para. 0026 of FAIN et al. for allegedly disclosing this additional feature of claim 2 (Office Action, pg. 4). Applicants respectfully disagree with the Office Action's interpretation of FAIN et al.

Para. 0026 of FAIN et al. is reproduced above. This section of FAIN et al. discloses comparing commercial records against a pay for performance search engine's listing to further categorize commercial records as either participating advertisers or non-participating advertisers. This section of FAIN et al. does not disclose or suggest identifying the query as a commercial query when the query is included in the predetermined list of commercial query patterns, as recited in claim 2. If this rejection is maintained, Applicants respectfully request that the Office explain how the above section of FAIN et al. can reasonably be construed as disclosing identifying the query as a commercial query when the query is included in the predetermined list of commercial query patterns, as recited in claim 2.

For at least the foregoing reasons, Applicants submit that claim 2 is not anticipated by FAIN et al.

Claim 3 recites that determining whether the query is a commercial query or a non-commercial query further includes determining, when the query is not included in the predetermined list of commercial query patterns, whether the query relates to at least one commercial query pattern in the predetermined list of commercial query patterns; identifying the query as a commercial query when the query relates to at least one

commercial query pattern in the predetermined list of commercial query patterns; and identifying the query as a non-commercial query when the query is unrelated to the predetermined list of commercial query patterns. FAIN et al. does not disclose or suggest this combination of features.

For example, FAIN et al. does not disclose or suggest determining, when the query is not included in the predetermined list of commercial query patterns, whether the query relates to at least one commercial query pattern in the predetermined list of commercial query patterns. The Office Action relies on para. 0057 for allegedly disclosing the above feature of claim 3 (Office Action, pg. 5). Applicants respectfully disagree with the Office Action's interpretation of FAIN et al.

At para. 0057, FAIN et al. discloses:

Therefore, the first step is to determine whether a page and/or the page's URL meet select criteria 32. There are many, many characteristics of a page that can be examined in order to ultimately determine whether the page is transactional in nature. These criteria include, determining whether the page includes the following: a field for entering credit card information; a field for a username and/or password for an online payment system such as PayPal<sup>TM</sup> or BidPay<sup>TM</sup>, a telephone number identified for a "sales office," a "sales representative," "for more information call," or any other transaction-oriented phrase; a link or button with text such as "click here to purchase," "One-Click<sup>TM</sup> purchase," or similar phrase, text such as "your shopping cart contains" or "has been added to your cart," and/or a tag such as a one-pixel GIF used for conversion tracking. Any text matching may be either on text strings, such as sequences of characters in the Unicode or ASCII character sets, or on text derived from optical character recognition of text rendered in images, or speech recognition on a sound recording presented in response to an http (Hyper Text Transfer Protocol) request. The criteria can be used in any combination and any individual criteria may be used or not used. Additionally, these criteria are only examples and do not constitute an exhaustive list.

This section of FAIN et al. discloses criteria used for determining whether a page is transactional in nature. This section of FAIN et al. does not relate to queries. Therefore, this section of FAIN et al. cannot disclose or suggest determining, when a received query is not included in a predetermined list of commercial query patterns, whether the query relates to at least one commercial query pattern in the predetermined list of commercial query patterns, as recited in claim 3.

Since FAIN et al. does not disclose or suggest determining, when a received query is not included in a predetermined list of commercial query patterns, whether the query relates to at least one commercial query pattern in the predetermined list of commercial query patterns, FAIN et al. cannot disclose or suggest identifying the query as a commercial query when the query relates to at least one commercial query pattern in the predetermined list of commercial query patterns and identifying the query as a non-commercial query when the query is unrelated to the predetermined list of commercial query patterns, as also recited in claim 3.

For at least the foregoing reasons, Applicants submit that claim 3 is not anticipated by FAIN et al.

Independent claims 9-11 recite features similar to (yet possibly of different scope than) features described above with respect to claim 1. Therefore, Applicants respectfully submit that claims 9-11 are not anticipated by FAIN et al. for at least reasons similar to reasons given above with respect to claim 1.

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

HARRITY SNYDER, L.L.P.

By: /John E. Harrity/  
John E. Harrity  
Registration No. 43,367

Date: December 20, 2006

11350 Random Hills Road  
Suite 600  
Fairfax, Virginia 22030  
(571) 432-0800

Customer Number: 44989